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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,767	01/08/2004	Kyung-Hoon Park	P/923-375	8717

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EXAMINER

CANNING, ANTHONY J

ART UNIT	PAPER NUMBER
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2879

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary

Application No.

10/754,767

Applicant(s)

PARK, KYUNG-HOON

Examiner

Anthony J. Canning

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-17 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date <u>12/05</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
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DETAILED ACTION

Acknowledgement of Amendment

1. The amendment to the instant application was entered on 13 February 2006.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 1 December 2005 was filed after the mailing date of the Non-Final rejection on 10 August 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner, except for the untranslated office action issued by the Japanese patent office, because it is not a published document and should be removed from the IDS.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-7 and 10-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner does

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not understand how something can be electrodeless when there is a protrusion serving as an electrode.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 10 recites the limitation "The electrodeless lamp of claim 9" in line 1. Claim 9 is cancelled, therefore there is insufficient antecedent basis for this limitation in the claim. To expedite the prosecution of this case, the examiner assumes claim 10 is supposed to depend from claim 16.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lapatovich et al. (J.P. 11-111238) (of record).

8. As to claims 16, Lapatovich et al. disclose an electrodeless lamp including: a transparent bulb portion forming a filling space having an incomplete spherical shape inside to be charged with a gas-fill generating plasma by electromagnetic energy (see Abstract Drawing, item 12; Abstract Solution paragraph); a stem portion extending from the bulb portion to a predetermined length to become a rotational shaft of the bulb portion (see Abstract Drawing, item 18); and a

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protruding portion extendingly formed at an inner circumference of the filling space of the bulb portion and serving as an electrode (see Abstract Drawing, item 14; Abstract Solution paragraph, since the structure of the protrusions is the same as claimed, the protrusions of Lapatovich et al. must also “serve as an electrode”).

9. As to claim 10, Lapatovich et al. disclose the electrodeless lamp of claim 10. Lapatovich et al. further disclose that the long axis of the oval bulb portion lies in the same line where the stem portion lies (see Abstract Figure; the long axis of the bulb runs through the stem portion).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-7, 11, 14, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapatovich et al. (J.P. 11-111238) (of record) in view of MacLennan et al. (U.S. 5,903,091).

12. As to claims 1 and 17, Lapatovich et al. disclose a lamp comprising: a transparent bulb portion (see Abstract Drawing, item 12; Abstract Solution paragraph) forming a filling inside to be charged with a gas-fill (Abstract Solution paragraph) a stem portion extending from the bulb portion to a predetermined length to become a rotational shaft of the bulb portion (see Abstract Drawing, item 18); and a protruding portion protruding from an inner circumference of the bulb portion (see Abstract Drawing, item 14; Abstract Solution paragraph, since the structure of the

protrusions is the same as claimed, the protrusions of Lapatovich et al. must also “serve as an electrode”). Lapatovich et al. fail to disclose that the bulb is a complete sphere on the inside.

MacLennan et al. disclose an electrodeless lamp with a spherical transparent bulb (column 4, lines 54-55; column 10, lines 12-16). MacLennan et al. disclose that the shape of the bulb is variable (column 10, lines 12-15), and that a spherical bulb can be blow molded which results in a bulb that is dimensionally controlled (column 5, lines 37-41).

Therefore, it would have been obvious to one having ordinary skill in the art. at the time the invention was made, to modify the lamp of Lapatovich et al. to include that the lamp has a spherical bulb, as taught by MacLennan et al., since a spherical bulb can be blow molded which results in a bulb that is dimensionally controlled.

13. As to claim 6, Lapatovich et al. and MacLennan et al. disclose the electrodeless lamp of claim 1. Lapatovich et al. further disclose that the protruding portion is formed like a ring figure protruding from the inner circumference of the bulb portion with uniform width and height (see Abstract Figure, item 14; Abstract Solution paragraph).

14. As to claim 7, Lapatovich et al. and MacLennan et al. disclose the electrodeless lamp of claim 6. Lapatovich et al. further disclose that the ring figure lies vertical to an axis extending from the same axis of the stem portion (see Abstract Drawing, item 18; if the bulb is turned on its side and the horizontal axis runs through the stem portion the rings lie on vertical axis with respect to the horizontal axis).

15. As to claim 14, Lapatovich et al. and MacLennan et al. disclose the electrodeless lamp of claim 1. Lapatovich et al. further disclose that the protruding portion is formed of the same

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material of the bulb portion (see Abstract Drawing, item 14; the protrusion is a thickening of the bulb interior).

16. As to claims 2-5 and 11, Lapatovich et al. and MacLennan et al. disclose the invention as claimed, but fail to disclose that the protruding portion include a pair of protruding portions or at least two protruding portions. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

17. As to claim 15, Lapatovich et al. disclose a lamp comprising: a transparent bulb portion (see Abstract Drawing, item 12; Abstract Solution paragraph) forming a filling inside to be charged with a gas-fill (Abstract Solution paragraph) a stem portion extending from the bulb portion to a predetermined length to become a rotational shaft of the bulb portion (see Abstract Drawing, item 18); and a protruding portion protruding from an inner circumference of the bulb portion (see Abstract Drawing, item 14; Abstract Solution paragraph, since the structure of the protrusions is the same as claimed, the protrusions of Lapatovich et al. must also “serve as an electrode”). Lapatovich et al. fail to disclose that the bulb is a complete sphere on the inside, and that there is a pair of protrusions.

MacLennan et al. disclose an electrodeless lamp with a spherical transparent bulb (column 4, lines 54-55; column 10, lines 12-16). MacLennan et al. disclose that the shape of the bulb is variable (column 10, lines 12-15), and that a spherical bulb can be blow molded which results in a bulb that is dimensionally controlled (column 5, lines 37-41).

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Regarding the limitation of the pair of protrusions, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify the lamp of Lapatovich et al. to include that the lamp has a spherical bulb, as taught by MacLennan et al., since a spherical bulb can be blow molded which results in a bulb that is dimensionally controlled, and that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

18. The examiner acknowledges amendments to claims 1 and 15, the cancellation of claims 8 and 9, and newly added claims 16 and 17.

19. In light of the amendments, the examiner has given a new rejection.

20. By virtue of the amendment to claim 1, the previously noted allowable subject matter of claims 12 and 13 is withdrawn.

Final Rejection

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information


22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Canning whose telephone number is (571)-272-2486. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh D. Patel can be reached on (571)-272-2457. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Canning 

1 May 2006


ASHOK PATEL
PRIMARY EXAMINER